(D) REMARKS, including DRAWING AMENDMENTS, if any

In Re PARA 1 of the Action

Acknowledged; no response required.

In Re PARA 2 of the Action

Filed herewith is a copy of EP 1 000 741 A2 per the Examiner's request.

In Re PARA 3, 4 of the Action

The Action alleges the judicially created doctrine of obviousness-type double patenting in view of applicant/assignee's own U.S. Pat. No. 6,556,470 B1 (Vincent '470 hereinafter). Applicants respectfully and strongly disagree.

Vincent '470 (assignment to HP recorded at reel 012515/frame 0849) has the same inventors and assignee as the present application (reel 012650/frame 0734). Vincent '470 was filed July 31, 2001, less than 3 months prior to the present application. It is not a proper reference under Sec. 102 nor Sec. 103 nor the above-mentioned doctrine.

Furthermore on the merits, one must consider the technologies described. Vincent '470 discloses and claims a "colorant" (independent Claims 1, 2, 3, 5 and 7). The *present application* is for an *electronic book and methods related thereto*. Alleging that an electronic book is obvious from a colorant seems to the inventors herein to be technologically equivalent to alleging paper is obvious from the knowledge of ink. The allegation ignores the claims' elements for all of the additional subunits or devices required to render a commercial product and process from the patented molecular colorant.

Moreover, the allegation ignores the statutory right to patent "...any new and useful...machine...or any new and useful improvement...." 15 U.S.C. 101. At the least,

arguendo, the present application relates to a new and useful improvement to electronic book technology.

Moreover, the present application sets forth method claims and thus also falls within the provisions of 15 U.S.C. 100(b): "...method...includes a new use of a know process, machine, manufacture, composition of matter, or material."

On one or more of the abovesaid grounds, it is respectfully requested that the rejection be withdrawn.

In Re Rejections Under 103(a), Action Para. 5 - 6

Pending claims 1-3, 10-13, 16-18, 20, 21, 35-37, 40-42, 44, 45, 48 are rejected under the combination of U.S. Pat. No. 5,937,158 in view of U.S. Pat. No. 6,045,955 (Vincent '955). Claims 1, 16, 35, and 44 are independent claims.

Vincent '955 is also assigned to the common Assignee herein Hewlett-Packard Company. It is not a proper reference as it falls within 15 U.S.C. 103(c).

Moreover, on the alleged technical merits, Vincent '955 does not relate to a "molecular colorant," as claimed herein; it only relates to "microcapsule" technology. See FIG. 1A-2, 8A, 8B and detailed description related thereto. Fundamental technological differences between the molecular-level switches described in the Detailed Description and the Appendix and "microcapsules" which are discussed in the Background and the references must be considered when analyzing the claims of the present application and alleged material references.

Furthermore, a dependent claim includes all the limitations of the claim from which it depends and, as such, makes specific that which was general. 35 USC 112; 37 C.F.R. Sec. 1.75(c); Allen Group, Inc. V. Nu-Star, Inc., 197 USPQ 849 (7th Cir. 1978); Ex parte Hansen, 99 USPQ 319 (Pat. Off. Bd. App. 1953). Dependent claims are non-obvious if the independent claims from which they depend are non-obvious. In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988);

see also Hartness International, Inc. V. Simplimatic Engineering Co., 2 USPQ2d 1826, 1831 (Fed. Cir. (1987) to the same effect re novelty). Thus, allowance of a base claim as patentable normally results in allowance of a claim dependent upon that claim.

It is respectfully requested that the rejections be withdrawn.

In Re Rejections Under 103(a), Action Para. 7

The Remarks above regarding Para. 5-6 of the Action are incorporated by reference with respect to the rejection of claims 4-9, 19, 22-29 under Uranaka in view of Vincent '955 and further in view of U.S. Patent No. 6,498,579 B1 (Sawano).

It is respectfully requested that the rejections be withdrawn.

In Re Rejections Under Sec. 103(a), Para. 8 of the Action

Claims 14, 15, 38, 39, 46, and 47 (all being dependent claims) are rejected under Uranaka in view of Vincent '955 and further in view of previously cited Chen.

The Remarks above regarding Para. 5-6 of the Action are incorporated by reference. It is respectfully requested that the rejections be withdrawn.

In Re Rejections Under 103(a), Action Para. 9

Claims 30 -32 are rejected under Sawano in view of Vincent '955. Claim 30 is an independent claim.

The Remarks above regarding Para. 5-6 of the Action are incorporated by reference. It is respectfully requested that the rejections be withdrawn.

In Re Rejections under Sec. 103(a), Action Para. 10

Claims 33 and 34, both dependent claims are rejected under Sawano in view of Vincent '955 and Chen.

The Remarks above regarding Para. 5-6 of the Action are incorporated by reference. It is respectfully requested that the rejections be withdrawn.

In Re Action Para. 11-15

No response required.

Based upon the foregoing, it is submitted that the application now presents claims which are directed to novel, unobvious and distinct features of the present invention which are an advancement to the state of the art. Reconsideration and early allowance of all claims is respectfully requested. The right is expressly reserved to reassert any and all arguments, including the raising of new arguments, should a Notice of Allowance not be forthcoming.

Questions or suggestions that will advance the case to allowance may be directed to the undersigned by teleconference at the Examiner's convenience.

Date: FEB. 24, 2004

Respectfully submitted,
Hewlett-Packard Company

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